REMARKS

Claims 1, 2,4-8, 6-9, 10, 11, 13, 15, 16 and 18 are rejected under 35 USC 103(a) as being unpatentable over International Application Publication No. 99/60351 (hereinafter Lofall) in view of US Pat. No. 5,922,963 (hereinafter Piety). Claims 3, 9, 12, 14, 17 and 19 stand rejected under 35 USC 103(a) as being unpatentable over Lofall in view of Piety and further in view of EP Publication No. 0 908 805 (hereinafter Hoth).

The specification has been amended to correct the informalities noted in the Office Action. It is noted that these corrections moot the objection to the drawings being that the specification now includes the missing reference numeral indicated in the Office Action. Accordingly, each of the objections noted in the Office Action should be withdrawn.

Claims 1 and 18 have been amended to emphasize aspects of the present invention. Claims 2, 3, 9, 11, 12, 14, 16, 17 and 19 have been cancelled. Claims 1, 4-8, 10, 13, 15, and 18 remain pending.

Claim 1 in part recites that the operating states of the object to be tested are characterized by a second operating parameter which is proportional to a load of the object to be tested, and are also characterized by a third operating parameter which is proportional to a temperature of the object to be tested. The amplitude values of the alarm curve are changed according to the second operating parameter, and the third operating parameter.

The Office Action correctly acknowledges that the combination of Lofall and Piety fails to describe that the alarm curve is also adjusted based on temperature. The Office Action then cites Hoth as purportedly overcoming the deficiencies of the Lofall/Piety combination. However, Hoth actually teaches away from the structural and/operational relationships recited in claim 1 regarding the utilization of temperature. More particularly, Hoth uses temperature data as a multiplier for adjusting a calculated probability of failure numbers, whereas claim 1 recites temperature as a basis for adjusting an alarm curve.

Accordingly, the Lofall/Piety/Hoth combination does not constitute an appropriate *prima facie* combination for rejecting claim 1 under 35 USC 103(a), and this rejection (as well as the rejection of claims depending from claim 1) should be withdrawn.

Applicant will now discuss an alternative basis as to why the Lofall/Piety/Hoth combination does not constitute an appropriate *prima facie* combination for rejecting claims under 35 USC 103(a). Applicant discussed in particular detail in a previous response the substantial differences in the approach of Hoth compared to the claimed invention. For the sake of brevity, this discussion will not be repeated here. However, applicant submits that due to such differences, the resulting combination of references (Lofall/Piety/Hoth) fails to enable the claimed invention. "To render a later invention unpatentable for obviousness, the prior art must enable the later invention." (Citations omitted) The Hoth reference fails to enable the claimed invention since it fails to teach any method for automatically changing the amplitude values of an alarm curve based on temperature. The use of temperature data, as actually described by Hoth, would not enable the claimed invention. The simply say that since Hoth uses temperature (albeit in a completely different manner as in the claimed invention), then Hoth remedies the shortcomings of Lofall and Piety is not enough in view that the specific approach described by Hoth cannot be disregarded since such an approach would make the claimed invention inoperable for its intended purpose. One of ordinary skill in the art would not have been motivated to combine the vastly different approach described by Hoth with the Lofall/Piety combination. Thus, on this alternative basis, applicant submits that the combination of Lofall/Piety/Hoth does not support the rejections under 35 USC 103.

Claim 18 in part recites adjusting the alarm curve to account for a difference between first and second temperatures. As discussed above, Hoth not only fails to teach the foregoing operational relationship but actually teaches away from it, or, in the alternative, Hoth fails to enable the claimed invention. Accordingly, the Lofall/Piety/Hoth combination does not constitute an appropriate *prima facie* combination for rejecting claim 18 under 35 USC 103(a), and this rejection should be similarly withdrawn.

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Conclusion

It is respectfully submitted that each of the claims pending in this amended application recites patentable subject matter, and it is further submitted that such claims comply with all statutory requirements and thus each of such claims should be allowed.

The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, including the fees specified in 37 C.F.R. §§ 1.16 (c), 1.17(a)(1) and 1.20(d), or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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